

REMARKS

Claims 1-15 are pending in the above-referenced patent application. No claims have been cancelled, added or amended.

Status of Claims

In the Final Office Action, the Examiner rejected claims 1, 6 and 11 under 35 U.S.C 103(a) as being unpatentable over Sung (US Patent No. 6,587,231) in view of Matsumoto (US Patent No. 6,147,339); rejected claims 2,7 and 12 under 35 U.S.C 103(a) as being unpatentable over Sung in view of Matsumoto and further in view of Hu et al. (US Patent No. 6,271,939, hereinafter "Hu"); and rejected claims 3, 5, 8, 10 13 and 15 under 35 U.S.C 103(a) as being unpatentable over Sung in view of Matsumoto and further in view of Motamed (US Patent No. 6,327,047). These rejections are respectfully traversed.

Sung v. Matsumoto**1. Failure of References to teach all limitations****2. Lack of Motivation to Combine**

Referring now to claims 1, 6 and 11, Assignee respectfully submits that these claims are not rendered obvious by the cited art, Sung in view of Matsumoto. It is noted that in order to establish *prima facie* obviousness there must be some suggestion or motivation to modify or combine reference teachings, and the combination, if successful, must teach or suggest all of the claim limitations. As stated in the Manual for Patent Examining Procedure (MPEP), § 2142/2143, "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined)

must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." It is respectfully submitted that the cited references do not meet these criteria. For example, the cited references do not include any suggestion or motivation to combine, and the cited references, if successfully combined, would still not teach or suggest all the claim limitations.

The Examiner already concedes that Sung is lacking at least one element of the rejected claims. According to the Examiner, "Sung does not specify that the transparent material used to make the transparent housing in acrylic." Additionally, it is noted that claim 1 is directed to a "document-loading panel" and not a housing. Additionally, although Assignee does not necessarily agree with the Examiner's characterization of the rejected claims, it is respectfully submitted that Sung, whether viewed alone or in combination with Matsumoto, does not show or describe at least "a transparent acrylic document-loading panel".

However, Assignee does not by this argument accept that the combination is proper; rather, while Assignee asserts that the combination is improper, Assignee further asserts that even if the combination were proper, and a successful combination of Sung and Matsumoto were made, any resultant combination or any of the other alleged combinations would still not show or describe at least "a transparent acrylic document-loading panel".

Failure to Teach Document Loading Panel, Acrylic Document Loading Panel

As just an example, the cited portion of Sung (Fig. 1, col.2, lines 35-42) describes two transparent windows (2,3) which form separate parts, not integral with the housing. There is no disclosure or suggestion in Sung that "a document-loading panel is made of a transparent acrylic material", as recited in claim 1.

Furthermore, the Matsumoto reference concerns a hand-held portable scanner that rolls over a document during a scanning procedure. Thus, the transparent window (18) located at the bottom of the apparatus according to Matsumoto does not constitute a document-loading panel, as the portable scanner apparatus of Matsumoto does not hold documents. It is therefore submitted that the cited

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references themselves provide no suggestion to apply the teaching of an acrylic window used in a roller scanner that does not hold documents to a scanner apparatus in which the transparent window does hold documents. Therefore, it is respectfully submitted that there is no suggestion to combine the cited references, and the cited references, if successfully combined, would still not teach or suggest all the claim limitations. Therefore, it is respectfully submitted that the cited references do not render claim 1 obvious. Additionally, claims 6 and 11 are not rendered obvious for at least the same reasons.

Sung v. Matsumoto v. Hu

The Examiner has rejected claims 2, 7 and 12 under 35 USC 103(a) based on Sung in view of Matsumoto and further in view of Hu. It is respectfully submitted that Hu does not cure the deficiencies of Sung and Matsumoto discussed above, and does not show or describe the limitations of the rejected claims. Therefore, claims 2, 7 and 12 are not rendered obvious for at least the same reasons as presented with reference to claims 1, 6 and 11, above. It is respectfully requested that the Examiner withdraw the rejection to these claims.

Sung v. Matsumoto v. Motamed

The Examiner has rejected claims 3, 5, 8, 10, 13 and 15 under 35 USC 103(a) based on Sung in view of Matsumoto and further in view of Motamed. It is respectfully submitted that Motamed does not cure the deficiencies of Sung and Matsumoto discussed above, and does not show or describe the limitations of the rejected claims. Therefore, claims 3, 5, 8, 10, 13 and 15 are not rendered obvious for at least the same reasons as presented with reference to claims 1, 6 and 11, above. It is respectfully requested that the Examiner withdraw the rejection to these claims.

Sung v. Matsumoto v. Pan

The Examiner has rejected claims 4, 9 and 14 under 35 USC 103(a) based on Sung in view of Matsumoto and further in view of Pan. It is respectfully submitted that Pan does not cure the deficiencies of Sung and Matsumoto discussed above, and does not show or describe the limitations of

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the rejected claims. Therefore, claims 4, 9 and 14 are not rendered obvious for at least the same reasons as presented with reference to claims 1, 6 and 11, above. It is respectfully requested that the Examiner withdraw the rejection to these claims.

Conclusion - Claims are not Prima Facie Obvious

Assignee respectfully submits that because a *prima facie* case of obviousness has not been established, claims 1-15 are in a condition for allowance. It is noted that many other bases for traversing the rejections could be provided, but Assignee believes that the grounds presented above are sufficient. It is, therefore, respectfully requested that the Examiner withdraw the rejection of these claims.

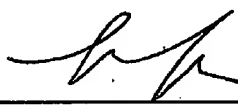
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CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, she is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Respectfully submitted,

Dated: 4-10-06

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